



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/779,573

02/13/2004

David Wilson

3219-000011

9304

27572 7590 06/25/2008
HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/779,573 | Applicant(s) WILSON, DAVID | |
| | Examiner LENA NAJARIAN | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040213</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

In the present case, claims 1-19 only recite mental steps. In order to qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The recited steps of exemplary claim 1 of merely providing an indicator, providing a reimbursement claim mechanism, and processing a reimbursement claim are not tied to another statutory class (such as a particular apparatus) and do not transform underlying subject matter (such as an article or materials) to a different state or thing. Similar analysis applies for independent claims 13, 17, and 19. Therefore, claims 1-19 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 7-9, 12-15, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Drunsic (US 2002/0147678 A1).

(A) Referring to claim 1, Drunsic discloses a method of facilitating reimbursement for a qualified medical care product from a reimbursement account, comprising (abstract, paragraphs 31 and 33 of Drunsic):

providing an indicator that the qualified medical care product is eligible or may be eligible for reimbursement (paragraphs 58 & 59 of Drunsic);

providing a reimbursement claim mechanism in connection with the qualified medical care product (paragraph 64 of Drunsic); and

processing a reimbursement claim for the qualified medical care product (paragraph 43 of Drunsic).

(B) Referring to claim 2, Drunsic discloses wherein the indicator is further defined as a certification mark (paragraph 82 of Drunsic).

(C) Referring to claim 7, Drunsic discloses wherein the reimbursement claim mechanism is further defined as information identifying the reimbursement

Art Unit: 3626

account presented contemporaneously with the purchase of the qualified medical care product (para. 74 of Drunsic).

(D) Referring to claim 8, Drunsic discloses wherein the identifying information is a participant identifying number embodied on a card (para. 74 of Drunsic).

(E) Referring to claim 9, Drunsic discloses wherein the reimbursement claim is reimbursed from a reimbursement account established in accordance with §125 of the Internal Revenue Code (para. 61 of Drunsic).

(F) Referring to claim 12, Drunsic discloses wherein the step of reimbursing further comprises reimbursing the lesser amount of either a requested amount or a manufacturer's wholesale price (para. 31 & 37 of Drunsic).

(G) Referring to claim 13, Drunsic discloses a method of facilitating reimbursement for a qualified medical care product from a reimbursement account, comprising (abstract, para. 31, and para. 33 of Drunsic):

advertising that a qualified medical care product is eligible for or may be eligible for reimbursement (para. 7-13, para. 58, and para. 59 of Drunsic);

providing a reimbursement claim mechanism in connection with the qualified medical care product (para. 64 of Drunsic); and

reimbursing a reimbursement claim for the qualified medical care product upon receipt of the reimbursement claim mechanism from a participant of a plan (para. 64 of Drunsic).

(H) Referring to claim 14, Drunsic discloses wherein the step of advertising further comprises placing an indicator on the qualified medical care product,

Art Unit: 3626

where the indicator signifies that the qualified medical care product is eligible or may be eligible for reimbursement (para. 58 & 59 of Drunsic).

(I) Claims 15 repeats the same limitations as claim 2, and is therefore rejected for the same reasons given above.

(J) Referring to claim 17, Drunsic discloses a method for obtaining reimbursement for a qualified medical care product from a reimbursement account, comprising (abstract of Drunsic):

receiving a reimbursement claim form in connection with the purchase of the qualified medical care product (para. 31 and para. 42 of Drunsic);

submitting the reimbursement claim form to an entity responsible for administering the reimbursement account (para. 43 of Drunsic); and

receiving reimbursement for the qualified medical care product from said entity (para. 43 of Drunsic).

(K) Referring to claim 19, Drunsic discloses a method for obtaining reimbursement for a qualified medical care product from a reimbursement account, comprising (para. 64 and abstract of Drunsic):

selecting a qualified medical care product for purchase; transacting a purchase of the qualified medical care product (para. 74 and para. 80 of Drunsic); and

initiating a reimbursement claim for the qualified medical care product substantially contemporaneously with the purchase transaction (para. 74 of Drunsic).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drunsic (US 2002/0147678 A1) in view of Ruttenberg (US 2004/0103570 A1).

(A) Referring to claims 3, 4, and 18, Drunsic discloses the consumer being informed that the qualified medical care product is eligible for or may be eligible for reimbursement (para. 75 of Drunsic).

Drunsic does not disclose wherein the indicator is connected to packaging of the qualified medical care product, wherein the indicator is placed on an advertising display proximate to the qualified medical care product, and purchasing the qualified medical care product after viewing an advertisement.

Ruttenberg discloses wherein the indicator is connected to packaging of the product, wherein the indicator is placed on an advertising display proximate to the product, and purchasing the product after viewing an advertisement (para. 42, 3, 18, and Fig. 16 of Ruttenberg).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Ruttenberg

Art Unit: 3626

within Drunsic. The motivation for doing so would have been to optimize viewing of advertisements for the customer (para. 11 of Ruttenberg).

7. Claims 5, 6, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drunsic (US 2002/0147678 A1).

(A) Referring to claim 5, Drunsic discloses wherein the reimbursement claim mechanism is further defined as a claim form (para. 32 and para. 34 of Drunsic). However, Drunsic does not disclose that the claim form is placed in packaging of the product. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include the form in the packaging with the motivation of having the form immediately available to the consumer.

(B) Referring to claim 6, Drunsic discloses wherein the claim form identifies the qualified medical care product being purchased and is configured to receive information regarding purchase price, purchase date, and a participant associated with the reimbursement account (para. 42 of Drunsic).

(C) Referring to claim 11, Drunsic does not expressly disclose wherein the reimbursement claim is reimbursed from a reimbursement account established in accordance with §223 of the Internal Revenue Code. However, at the time of the invention it would have been obvious to a person of ordinary skill in the art to include the aforementioned arrangement in order to follow the tax laws pertaining to health savings accounts.

(D) Claim 16 repeats the same limitations as claim 5, and is therefore rejected for the same reasons given above.

Art Unit: 3626

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drunsic (US 2002/0147678 A1) in view of Raskin et al. (US 2001/0037214 A1).

(A) Referring to claim 10, Drunsic does not expressly disclose wherein the reimbursement claim is reimbursed from a reimbursement arrangement established in accordance with §105 of the Internal Revenue Code.

Raskin discloses wherein the reimbursement claim is reimbursed from a reimbursement arrangement established in accordance with §105 of the Internal Revenue Code (para. 20 of Raskin).

At the time of the invention, it would have been obvious to a person ordinary skill in the art to combine the aforementioned feature of Raskin within Drunsic. The motivation for doing so would have been to follow the tax laws (para. 21 of Raskin).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches an advertising method and system (5,809,481); a system and method for processing flexible spending account transactions (US 7,174,302 B2); a software, apparatus, and method for hand-held electronic devices and advertising thereon (US 2001/0032124 A1); and a debit card case with data register (US 2005/0035006 A1).

Art Unit: 3626

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./
Examiner, Art Unit 3626
In
6/17/08

/Robert Morgan/
Primary Examiner, Art Unit 3626

